

AMENDMENTS TO THE DRAWINGS:

Please amend the drawings as indicated in the attached sheet. In particular, a legend of "Prior Art" has been added to Fig. 13.

Attachment: Replacement Sheet including Figure 13 (1 page).

REMARKS

In the Office Action, the Examiner took the following actions:

objected to the drawings;

objected to the specification;

rejected claims 1-16 under 35 U.S.C. § 112, second paragraph;

rejected claims 1, 2, and 4-6 under 35 U.S.C. § 102(b) as being unpatentable over *DeRemigis* (U.S. Patent No. 4,097,153);

rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *DeRemigis* in view of *Saxe* (U.S. Patent No. 5,325,220);

rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over *DeRemigis* in view of *Goldfarb* (U.S. Patent No. 5,575,936);

rejected claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over *DeRemigis* in view of *Zeineh* (U.S. Patent No. 4,025,200);

rejected claims 10-13 under 35 U.S.C. § 103(a) as being unpatentable over *DeRemigis* in view of Yano et al. (U.S. Patent No. 4,123,841, "*Yano*");

rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *DeRemigis* in view of *Yano* and further in view of *Goldfarb*; and

rejected claims 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over *DeRemigis* in view of *Yano* and further in view of *Zeineh*.

Applicants have amended claims 1-16 and claims 1-16 remain under examination.

I. Regarding the Amendments to the Drawings

Applicants have amended Fig. 13 in a manner consistent with the Examiner's comments at page 2 of the Office Action. Specifically, Fig. 13 is designated as "Prior Art" in the attached replacement sheet. In addition, Applicants have amended the specification in a manner consistent with the Examiner's comments regarding element 104. Id. Specifically, the specification is amendment to recite "The cell 101 is also provided at each lateral side thereof with a transparent quartz glass 404". Accordingly, Applicants deem the Examiner's objections to the drawings addressed and respectfully request that the Examiner withdraw the objection to the drawings.

II. Regarding the Amendments to the Specification

Applicants have amended the specification as indicated above. In particular, Applicants have amended the paragraphs at pages 13 and 16 in a manner consistent with the Examiner's comments at page 3 of the Office Action. Accordingly, Applicants deem the Examiner's objection to the specification addressed and respectfully request that the Examiner withdraw the objection to the specification.

III. Regarding the Amendments to the Claims

Applicants have amended claims 1-16 to improve readability and to correct minor informalities.

IV. Regarding the rejection under 35 U.S.C. § 112, second paragraph

Applicants respectfully traverse the rejection of claims 1-16 under 35 U.S.C. § 112, second paragraph. Nevertheless, in order to expedite prosecution, Applicants have amended claims 1, 2, 5, 10, and 11. Claim 1 is amended to recite “an other electrode opposite to the transparent electrode.” Claims 2, 5, 10, and 11 are also amended in a manner consistent with the Examiners comments at pages 3 and 4 of the outstanding Office Action. It is respectfully submitted that claims as amended fully meet the requirements of 35 U.S.C. § 112, second paragraph. Therefore, Applicants respectfully request reconsideration and withdrawal of claims 1-16 under 35 U.S.C. § 112, second paragraph.

V. Regarding the rejection of claims 1, 2, and 4-6 under 35 U.S.C. § 102(b)

Applicant respectfully traverses the rejection of claims 1, 2, and 4-6 under 35 U.S.C. § 102(b) as being anticipated by *DeRemigis* because the reference fails to anticipate these claims.

In order to support a rejection under 35 U.S.C. § 102, each and every element of each claim at issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 recites, in part, “a transparent electrode forming a part of the at least one cell wall.” In contrast, *DeRemigis* teaches an “apparatus includ[ing] a sample cell 22

having a pair of spaced parallel electrodes 24 and . . . [26] [sic]." Col. 2, lines 65-67.

DeRemigis appears to teach a first electrode is formed in a top portion of cell 22 and a second electrode is formed opposite of the first electrode with in the cell. *DeRemigis*, however, does not teach at least "a transparent electrode forming a part of the at least one cell wall," as recited in claim 1. Accordingly, *DeRemigis* does not anticipate claim 1 because the reference fails to teach each and every element recited in claim 1.

Claim 1 is allowable for at least the above reasons. Claims 2 and 4-6 depend from claim 1 and are allowable at least due to their dependence. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1, 2, and 4-6 under § 102(b).

VI. Regarding the rejection of claim 3 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *DeRemigis* in view of *Saxe* because no *prima facie* case of obviousness is established.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). "[I]n formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." *USPTO Memorandum* from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2. "[T]he analysis supporting a rejection ... should be made explicit" and it is "important to identify

a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the manner claimed.” *Id.* (citing *KSR Int’l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007)).

Claim 3 depends from claim 1 and, thus, incorporates each and every element recited therein. *DeRemigis* fails to teach or suggest “a transparent electrode forming a part of the at least one cell wall,” as recited in claim 1. *Saxe* fails to cure the deficiencies of *DeRemigis*. *Saxe* merely teaches an invention relating to light valves having electrodes comprising a low-emissivity, electrically conducting material (col. 1, lines 6-12). Accordingly, no *prima facie* case of obviousness is established with respect to claim 1 based on the combination of *DeRemigis* and *Saxe*. Therefore, claim 3 is allowable at least due to its dependence and Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 3 under § 103(a).

VII. Regarding the rejection of claim 7 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claim 7 under 35 U.S.C. § 103(a) as being unpatentable over *DeRemigis* in view of *Goldfarb* because no *prima facie* case of obviousness is established.

Claim 7 depends from claim 1 and, thus, incorporates each and every element recited therein. *DeRemigis* fails to teach or suggest “a transparent electrode forming a part of the at least one cell wall,” as recited in claim 1 for the reasons discussed above. *Goldfarb* fails to cure the deficiencies of *DeRemigis*. *Goldfarb* merely teaches a device for focusing a laser, using a focusing lens, along three axes (col. 4, lines 16-19). *Goldfarb*, however, does not teach or suggest “a transparent electrode forming a part of

the at least one cell wall," as recited in claim 1. No *prima facie* case of obviousness is established with respect to claim 1 based on the combination of *DeRemigis* and *Goldfarb*. Accordingly, claim 7 is allowable at least due to its dependence. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 7 under § 103(a).

VIII. Regarding the rejection of claims 8 and 9 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 8 and 9 as being unpatentable over *DeRemigis* in view of *Zeineh* because no *prima facie* case of obviousness is established.

Claims 8 and 9 depend from claim 1 and, thus, incorporate each and every element recited therein. *DeRemigis* fails to teach or suggest "a transparent electrode forming a part of the at least one cell wall," as recited in claim 1. *Zeineh* fails to cure the deficiencies of *DeRemigis*. *Zeineh* teaches utilizing laser light for densitometry and spectrophotometry (col. 3, lines 46-48). *Zeineh*, however, does not teach or suggest "a transparent electrode forming a part of the at least one cell wall," as recited in claim 1, and required by claims 8 and 9. No *prima facie* case of obviousness is therefore established with respect to claim 1 based on the combination of *DeRemigis* and *Zeineh*. Accordingly, claims 8 and 9 are allowable at least due to their dependence. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 8 and 9 under § 103(a).

IX. Regarding the rejection of claims 10-13 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 10-13 as being unpatentable over *DeRemigis* in view of *Yano* because no *prima facie* case of obviousness is established.

Claim 10 recites "an opaque electrode forming a part of the at least one cell wall." *DeRemigis* fails to teach or suggest at least this element for similar reasons as those discussed above with respect to claim 1. *Yano* fails to cure the deficiencies of *DeRemigis*. *Yano* merely teaches a method of manufacturing electrochromic display devices (col. 1, lines 5-6). No *prima facie* case of obviousness is established with respect to claim 10 based on *DeRemigis* and *Yano* because the references, either alone or in combination, fail to teach or suggest each and every element recited in claim 10.

Claim 10 is allowable for at least the above reasons. Claims 11-13 depend from claim 10 and are allowable at least due to their dependence. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 10-13 under § 103(a).

X. Regarding the rejection of claim 14 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claim 14 as being unpatentable over *DeRemigis* in view of *Yano* and in further view of *Goldfarb* because no *prima facie* case of obviousness is established.

Claim 14 depends from claim 10 and thus incorporates each and every element recited therein. *DeRemigis* and *Yano* fail to teach or suggest each and every element recited in claim 10 for the reasons discussed above. *Goldfarb* fails to cure the

deficiencies of *DeRemigis* and *Yano* for similar reasons already discussed above with respect to claim 7. Accordingly, the combination of the references fails to teach or suggest each and every element recited in claim 10 and required by claim 14. No *prima facie* case of obviousness is established with respect to claim 10 and claim 14 is allowable at least due to its dependence. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 14 under § 103(a).

XI. Regarding the rejection of claims 15 and 16 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 15 and 16 as being unpatentable over *DeRemigis* in view of *Yano* and in further view of *Zeineh* because no *prima facie* case of obviousness is established. Claims 15 and 16 depend from claim 10 and, thus, incorporates each and every element recited therein. *DeRemigis* and *Yano* fail to teach or suggest each and every element recited in claim 10 for the reasons discussed above. *Zeineh* fails to cure the deficiencies of *DeRemigis* and *Yano* for similar reasons to those already discussed above with respect to claims 8 and 9. Accordingly, the combination of the references fails to teach or suggest each and every element recited in claim 10 and required by claims 15 and 16. No *prima facie* case of obviousness is established with respect to claim 10 and claims 15 and 16 are allowable at least due to their dependence. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 15 and 16 under § 103(a).

XII. Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 9, 2007

By: Arthur Garrett Reg. No. 53,232
for Reg. No. 20,338

Attachment: Replacement Sheet including Figure 13 (1 page).